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Thomas Jozefiak

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

17

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED
JUN 02 2004
GROUP 1600

Paper No. 17

Application Number: 09/721,291
Filing Date: November 22, 2000
Appellant(s): JOZEFIK ET AL.

Jesse A Fecker
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 26, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claim 71 and claim 73 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). It is noted that in grouping, appellants recite claim 1 as group I and claim 2 as group II. This appears to be a typographic error since claim 71 and 73 are the claims on appeal and appellants clear state claims 71 and 73 should not stand or fall together.

Art Unit: 1617

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|--------------------|------|-------------|
| JP Patent 4-333694 | 1992 | Niike et al |
|--------------------|------|-------------|

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 71 and 73 are rejected under 35 U.S.C. 103(a)

These rejections are fully set forth in prior office action, paper No. 11.

(11) *Response to Argument*

1. Claims 71 and 73, the claims appealed, are directed to a composition comprising a polymer or copolymer having a repeating unit defined therein, and an inert carrier. Niike et al. teach a copolymer of metha acrylate ester and an ammonium bearing monomer, wherein a monomer is a substituted diallylammonium. The substituents may be methyl, ethyl, propyl, hydroxyethyl, hydroxylpropyl, and dihydroxylpropyl. See, particularly, the CA Abstract, and page 3 lines 1-19 in the patent. The polymer is in an emulsion composition. See the abstract and column 5, lines 18-28.
2. Niike et al. does not teach expressly the substituent is a dihydroxylpropyl.

Art Unit: 1617

3. However, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to employ dihydroxylpropyl group as the substituents because dihydroxylpropyl is one of the few known substituents. Regarding the recitation of “pharmaceutical” herein in the claims, note the claims are drawn to composition and therefore the preamble “pharmaceutical” does not carry any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Note water in the emulsion is an inert pharmaceutical adjuvant materials.

4. Appellants argue that since Niike et al. do not disclose a specific example wherein the substituents are dihydroxylpropyl groups, a copolymer containing such repeat unit would have not been obvious, or one of ordinary skill in the art would have not motivated to select a monomer with dihydroxypropyl groups. The arguments are not convincing. Particularly, Niike disclosed copolymers of metha acrylate ester and an ammonium bearing monomer, wherein a monomer is a substituted diallylammonium, dihydroxylpropyl group is one of the six possible substituents of the substituted diallylammonium. Employment of any one of the members of such small group would have been obvious to one of ordinary skill in the art in view of Niike’s teaching.

5. Appellants further assert that water employed by Niike et al. would not meet the limitation as “inert pharmaceutical adjuvant,” because the water employed by Niike could be

Art Unit: 1617

toxic. This assertion is groundless. Nowhere in Niike teach or suggest that the water employed therein has to be toxic.

It is noted the appealed claims read on a composition *comprising* two ingredients: the copolymer and water. Niike et al have fairly suggested a composition. Whether other ingredients may, or may not be presented in the suggested composition, is not relevant.


With respect to the remarks that Niike et al. do not provide any teaching or suggestion that copolymer would be successful as a pharmaceutical composition for fat-binding, note it is well settled that the “intended use” of a product or composition will not further limit claims drawn to a product or composition. See, e.g., In re Hack 114 USPQ 161. Further, a composition meeting the limitation herein claimed is a composition being useful for any purpose.

Even further, as stated above, regarding the recitation of “pharmaceutical” herein in the claims, note the claims are drawn to composition and therefore the preamble “pharmaceutical” does not carry any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1617

Respectfully submitted,


Shengjun Wang
Primary Examiner
Art Unit 1617

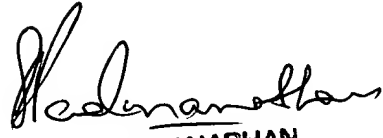
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May 29, 2004

Conferenced


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